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RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

ZORRO PRODUCTIONS, INC., a
California corporation

Plaintiff,

v.

MARS, INC., a Delaware corporation,
BBDO WORLDWIDE, INC., a New
York corporation.

Defendants.

Case No. **C10-01179**
COMPLAINT and DEMAND FOR JURY TRIAL
SC
ADR

Plaintiff ZORRO PRODUCTIONS, INC., ("ZPI" or "Plaintiff,") for its
complaint against Defendants, alleges as follows:

JURISDICTION

1. This Court has jurisdiction pursuant to 28 U.S.C., §§ 1331, 1338(a) and (b)
and 15 U.S.C., §1121. This Court has jurisdiction pursuant to 28 U.S.C., § 1367 of
the claims asserted by Plaintiff under the laws of the State of California.

INTRADISTRICT ASSIGNMENT

2. Pursuant to Civil L.R. 3-2(c), this matter is an Intellectual Property Action and is subject to district wide assignment, notwithstanding a substantial part of the events giving rise to the cause of the action occurred in Alameda County and a substantial part of the property that is the subject of the action is situated in Alameda County, which makes Oakland and/or San Francisco the proper assignment pursuant to Civil L.R. 3-2(d).

VENUE

3. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b) because Defendants transact business and purposefully avail themselves of the benefits of being in this judicial district, a substantial part of the events giving rise to the claim occurred in this judicial district and a substantial part of the property that is the subject of the action is situated in this district.

PARTIES

4. Plaintiff ZPI, is a California corporation with its principal place of business in the State of California, County of Alameda.

5. Defendant MARS, INC. is a Delaware corporation, and ZPI alleges, upon information and belief, that its principal place of business is in the State of Virginia.

1 6. Defendant BBDO WORLDWIDE, INC., is a New York corporation, and
2 ZPI alleges, upon information and belief, that its principal place of business is in the
3 State of New York.
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5 7. Plaintiff is unaware of the true names and capacities whether individual,
6 corporate, associate or otherwise of Defendants' other agents, employees, joint-
7 venturers, vendors, employers and partners, including but not limited to production
8 companies, and therefore, Plaintiff will seek leave of the Court to amend this
9 Complaint to allege those Defendants when the same have been ascertained.
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12 8. Plaintiff is informed and believes, and based thereon alleges, that in
13 performing the acts that give rise to this Complaint each of the Defendants named
14 herein was the agent, employee, joint-venturer, employer, partner, manager or
15 controlling entity of the other Defendant, and in doing the things hereinafter alleged,
16 was acting within the course and scope of such relationship. Plaintiff further alleges
17 that each of the Defendants named herein authorized, consented to and ratified all of
18 the alleged conduct, acts and omissions by the remaining Defendant with both actual
19 and constructive knowledge of said conduct.
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FIRST CAUSE OF ACTION
Violation of Lanham Act § 43(a)
(By ZPI Against All Defendants)

9. Plaintiff incorporates by reference Paragraphs 1 through 8 of the Complaint as if set forth in full herein.

10. ZPI is the owner of all rights, including without limitation, trademarks and trade dress, both registered and unregistered, associated with “Zorro,” the well-known fictitious character who has been widely popularized by ZPI and its licensees through depictions in, among other media, feature films, television programs, novels and comic books. ZPI and its licensees have extensively marketed, publicized and promoted “Zorro” through the use of distinctive depictions featuring “Zorro” as a masked fighter for justice, dressed in black, wearing a flat Cordoba hat and a cape, and brandishing a sword by which he generates the distinctive and separately trademarked “Z” and/or “Zorro.”

11. ZPI and its licensees have expended considerable effort and sums of money developing, advertising and marketing their distinctive character of “Zorro.” As a result of ZPI’s and its licensees’ activities, the trade and public at large have come to identify the “Zorro” character, trademarks and trade dress with ZPI’s and its licensees’ businesses. The “Zorro” character, trademarks and trade dress have

1 acquired secondary meaning by which "Zorro" is associated with Plaintiff and its
2 licensees and their goods and services.

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4 12. Defendants have developed, produced, adapted, distributed and exhibited
5 to the public in this district and in other locations in the United States television
6 commercials for the "M&M" candies which incorporate the "Zorro" character, by
7 using an actor wearing a trademarked "Zorro" Halloween costume in the
8 commercial. Defendants have also falsely and without authorization placed on the
9 unauthorized "Zorro" character in the television commercial Defendant Mars, Inc.'s
10 claim of ownership by placing its own trademark or other symbol of registration over
11 the actor wearing the trademarked "Zorro" Halloween costume. Defendants'
12 conduct of using the Zorro Halloween costume and placing its own registration mark
13 over it in the television commercial is confusingly similar to ZPI's protected "Zorro"
14 character, trademark and trade dress. Defendants' conduct has affected and will
15 affect interstate commerce.

16
17 13. Defendants' conduct has confused and is likely to confuse the public and
18 constitutes false designation of origin and false representation and description in
19 violation of Lanham Act § 43(a), 15 U.S.C. § 1125(a). Irreparable harm to ZPI is
20 imminent as a result of defendants' conduct, and ZPI is without an adequate remedy
21 at law. ZPI is entitled to an injunction restraining defendants, their officers,
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1 directors, agents, employees, representatives, partners and all other persons acting in
2 concert with them, from engaging in further such acts.

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4 14. ZPI is further entitled to recover from defendants the damages sustained
5 by ZPI as a result of defendants' acts. ZPI is presently unable to ascertain the full
6 extent of the monetary damages it has suffered by reason of defendants' acts, but ZPI
7 is informed and believes, and based thereon alleges, that ZPI has sustained damages
8 in an amount exceeding \$500,000.
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11 15. ZPI is further entitled to recover from defendants the gains, profits and
12 advantages they have obtained as a result of their said acts. ZPI is presently unable
13 to ascertain the full extent of the gains, profits and advantages defendants have
14 obtained by reason of their said acts, but ZPI is informed and believes, and based
15 thereon alleges, that defendants have obtained such gains, profits and advantages in
16 an amount exceeding \$500,000.
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20 16. ZPI is informed and believes and thereon alleges that defendants' acts are
21 intentional and were committed by defendants with the deliberate intent to trade on
22 ZPI's and its licensees' marks, trade dress and goodwill.
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24 WHEREFORE, Plaintiff prays for judgment against Defendants as set forth
25 more fully below.
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SECOND CAUSE OF ACTION
Violation of Lanham Act § 32
(Against All Defendants)

17. Plaintiff incorporates by reference Paragraphs 1 through 16 of the Complaint as if set forth in full herein.

18. ZPI is the owner of various trademarks registered with the United States Patent and Trademark Office pertaining to “Zorro,” including, without limitation, Registration No. 2,401,205, issued to ZPI on November 7, 2000, for the word “Zorro” found on its and its licensees’ Halloween costumes. ZPI is informed and believes and thereon alleges, that this includes the hang tag on the “Zorro” Halloween costume used without authorization by defendants in their television commercial.

19. Said registration is incontestible, is on the principal register, is in full force and effect and is owned by ZPI.

20. ZPI is the owner of other trademarks registered with the United States Patent and Trademark Office pertaining to “Zorro,” including pictorial depictions of “Zorro,” dressed in black, wearing a flat Cordoba hat, a mask and a cape such as that used by the defendants in their television commercial.

21. Defendants have developed, produced, adapted, distributed and exhibited to the public in this district and in other locations in the United States television

1 commercials for the "M&M" candies which incorporate the "Zorro" character, by
2 using an actor wearing a trademarked "Zorro" Halloween costume in the
3 commercial. Defendants have also falsely and without authorization placed on the
4 unauthorized "Zorro" character in the television commercial Defendant Mars, Inc.'s
5 claim of ownership by placing its own trademark or other symbol of registration over
6 the actor wearing the trademarked "Zorro" Halloween costume. Defendants'
7 conduct of using the Zorro Halloween costume and placing its own registration mark
8 over it in the television commercial is confusingly similar to ZPI's protected "Zorro"
9 character, trademark and trade dress. Defendants' conduct has affected and will
10 affect interstate commerce.

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12 22. Defendants' conduct has confused and is likely to confuse the public and
13 constitutes false designation of origin and false representation and description in
14 violation of Lanham Act § 32, 15 U.S.C. § 1114(1). Irreparable harm to ZPI is
15 imminent as a result of defendants' conduct, and ZPI is without an adequate remedy
16 at law. ZPI is entitled to an injunction restraining defendants, their officers,
17 directors, agents, employees, representatives and all other persons acting in concert
18 with them, from engaging in further such acts.

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20 23. ZPI is further entitled to recover from defendants the damages sustained
21 by ZPI as a result of defendants' acts. ZPI is presently unable to ascertain the full
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1 extent of the monetary damages it has suffered by reason of defendants' acts, but ZPI
2 is informed and believes, and based thereon alleges, that ZPI has sustained damages
3 in an amount exceeding \$500,000.
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5 24. ZPI is further entitled to recover from defendants the gains, profits and
6 advantages they have obtained as a result of their said acts. ZPI is presently unable
7 to ascertain the full extent of the gains, profits and advantages defendants have
8 obtained by reason of their said acts, but ZPI is informed and believes, and based
9 thereon alleges, that defendants have obtained such gains, profits and advantages in
10 an amount exceeding \$500,000.
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13 25. ZPI is informed and believes and thereon alleges that defendants' acts are
14 intentional and were committed by defendants with the deliberate intent to trade on
15 ZPI's and its licensees' marks, trade dress and goodwill.
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18 WHEREFORE, Plaintiff prays for judgment against Defendants as set forth
19 more fully below.
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21 **THIRD CAUSE OF ACTION**
22 **Dilution Under Lanham Act §43(c)**
23 **(Against All Defendants)**

24 26. Plaintiff incorporates by reference Paragraphs 1 through 25 of the
25 Complaint as if set forth in full herein.
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1 27. ZPI and its licensees have expended considerable effort and sums of
2 money developing, advertising and marketing their distinctive character of "Zorro."
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4 As a result of ZPI's and its licensees' activities, the "Zorro" character, trademarks
5 and trade dress have become so widely recognized and readily associated with ZPI's
6 and their licensees' businesses that the "Zorro" character, and the trademarks and
7 trade dress associated with "Zorro," are entitled to be recognized as famous marks
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9 under the Federal Trademark Dilution Revision Act of 2006, 15 U.S.C. § 1125(c).
10

11 28. Defendants have developed, produced, adapted, distributed and exhibited
12 to the public in this district and in other locations in the United States television
13 commercials for the "M&M" candies which incorporate the "Zorro" character, by
14 using an actor wearing a trademarked "Zorro" Halloween costume in the
15 commercial. Defendants have also falsely and without authorization placed on the
16 unauthorized "Zorro" character in the television commercial Defendant Mars, Inc.'s
17 claim of ownership by placing its own trademark or other symbol of registration over
18 the actor wearing the trademarked "Zorro" Halloween costume. Defendants'
19 conduct of using the Zorro Halloween costume and placing its own registration mark
20 over it in the television commercial dilutes the distinctive quality of the "Zorro"
21 character, trademark and trade dress, and goodwill associated with them in violation
22 of 15 U.S.C. § 1125 (c).
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1 29. Irreparable harm to ZPI is imminent as a result of defendants' conduct and
2 ZPI is without an adequate remedy at law. ZPI is entitled to an injunction restraining
3 defendants, their officers, directors, agents, employees, representatives and all other
4 persons acting in concert with them, from engaging in further such acts.
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6 30. ZPI is further entitled to recover from defendants the damages sustained
7 by ZPI as a result of defendants' acts. ZPI is presently unable to ascertain the full
8 extent of the monetary damages it has suffered by reason of defendants' acts, but ZPI
9 is informed and believes, and based thereon alleges, that ZPI has sustained damages
10 in an amount exceeding \$500,000.
11

12 31. ZPI is further entitled to recover from defendants the gains, profits and
13 advantages they have obtained as a result of their said acts. ZPI is presently unable
14 to ascertain the full extent of the gains, profits and advantages defendants have
15 obtained by reason of their said acts, but ZPI is informed and believes, and based
16 thereon alleges, that defendants have obtained such gains, profits and advantages in
17 an amount exceeding \$500,000.
18

19 32. ZPI is informed and believes and thereon alleges that defendants' acts are
20 intentional and were committed by defendants with the deliberate intent to trade on
21 ZPI's and its licensees' marks, trade dress and goodwill.
22

1 WHEREFORE, Plaintiff prays for judgment against Defendants as set forth
2 more fully below.
3

4 **FOURTH CAUSE OF ACTION**
5 **Common Law Unfair Competition Under California Law**
6 **(Against All Defendants)**

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8 33. Plaintiff incorporates by reference Paragraphs 1 through 32 of the
9 Complaint as if set forth in full herein.

10 34. This claim arises under the unfair competition laws of the State of
11 California. Jurisdiction is conferred upon the Court pursuant to 28 U.S.C. §§ 1338
12 (b) and 1367.
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15 35. ZPI and its licensees have expended considerable effort and sums of
16 money developing, advertising and marketing their distinctive character of “Zorro.”
17 As a result of ZPI’s and its licensees’ activities, the trade and public at large have
18 come to identify the “Zorro” character, trademarks and trade dress with ZPI’s and its
19 licensees’ businesses. The “Zorro” character, trademarks and trade dress have
20 acquired secondary meaning by which “Zorro” is associated with Plaintiff and its
21 licensees and their goods and services.
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25 36. Defendants have developed, produced, adapted, distributed and exhibited
26 to the public in this district and in other locations in the United States television
27 commercials for the “M&M” candies which incorporate the “Zorro” character, by
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1 using an actor wearing a trademarked "Zorro" Halloween costume in the
2 commercial. Defendants have also falsely and without authorization placed on the
3 unauthorized "Zorro" character in the television commercial Defendant Mars, Inc.'s
4 claim of ownership by placing its own trademark or other symbol of registration over
5 the actor wearing the trademarked "Zorro" Halloween costume. Defendants'
6 conduct of using the Zorro Halloween costume and placing its own registration mark
7 over it in the television commercial is confusingly similar to ZPI's protected "Zorro"
8 character, trademark and trade dress.
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12 37. Defendants' conduct has caused, and is likely to cause, public confusion,
13 deception and mistake, and infringes ZPI's rights, including its marks and trade
14 dress, in the "Zorro" character. Irreparable harm to ZPI is imminent as a result of
15 defendants' conduct, and ZPI is without an adequate remedy at law. ZPI is entitled
16 to an injunction restraining defendants, their officers, directors, agents, employees,
17 representatives and all other persons acting in concert with them, from engaging in
18 further such acts.
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22 38. ZPI is further entitled to recover from defendants the damages sustained
23 by ZPI as a result of defendants' acts. ZPI is presently unable to ascertain the full
24 extent of the monetary damages it has suffered by reason of defendants' acts, but ZPI
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1 is informed and believes, and based thereon alleges, that ZPI has sustained damages
2 in an amount exceeding \$500,000.
3

4 39. ZPI is further entitled to recover from defendants the gains, profits and
5 advantages they have obtained as a result of their said acts. ZPI is presently unable
6 to ascertain the full extent of the gains, profits and advantages defendants have
7 obtained by reason of their said acts, but ZPI is informed and believes, and based
8 thereon alleges, that defendants have obtained such gains, profits and advantages in
9 an amount exceeding \$500,000.
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12 40. ZPI is informed and believes and thereon alleges that defendants' acts are
13 intentional and were committed by defendants with the deliberate intent to trade on
14 ZPI's and its licensees' marks, trade dress and goodwill.
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17 WHEREFORE, Plaintiff prays for judgment against Defendants as set forth
18 more fully below.
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20 **FIFTH CAUSE OF ACTION**
21 **Violation of California Business and Professions Code §§ 14245, 14247 and**
22 **17200, *et. seq.***
23 **(Against All Defendants)**

24 41. Plaintiff incorporates by reference Paragraphs 1 through 40 of the
25 Complaint as if set forth in full herein.
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1 42. This claim arises under the unfair competition laws of the State of
2 California. Jurisdiction is conferred upon the Court pursuant to 28 U.S.C. §§ 1338
3 (b) and 1367.

4
5 43. ZPI and its licensees have expended considerable effort and sums of
6 money developing, advertising and marketing their distinctive character of "Zorro."
7 As a result of ZPI's and its licensees' activities, the trade and public at large have
8 come to identify the "Zorro" character, trademarks and trade dress with ZPI's and its
9 licensees' businesses. The "Zorro" character, trademarks and trade dress have
10 acquired secondary meaning by which "Zorro" is associated with Plaintiff and its
11 licensees and their goods and services.

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13 44. As a result of ZPI's and its licensees' activities, the "Zorro" character,
14 trademarks and trade dress have become so widely recognized and readily associated
15 with ZPI's and their licensees' businesses that the "Zorro" character, and the
16 trademarks and trade dress associated with "Zorro," are entitled to be recognized as
17 famous marks under California Business and Professions Code § 14247.

18
19 45. Defendants have developed, produced, adapted, distributed and exhibited
20 to the public in this district and in other locations in the United States television
21 commercials for the "M&M" candies which incorporate the "Zorro" character, by
22 using an actor wearing a trademarked "Zorro" Halloween costume in the
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1 commercial. Defendants have also falsely and without authorization placed on the
2 unauthorized “Zorro” character in the television commercial Defendant Mars, Inc.’s
3 claim of ownership by placing its own trademark or other symbol of registration over
4 the actor wearing the trademarked “Zorro” Halloween costume. Defendants’
5 conduct of using the Zorro Halloween costume and placing its own registration mark
6 over it in the television commercial is confusingly similar to ZPI’s protected “Zorro”
7 character, trademark and trade dress.
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11 46. Such acts of Defendants as described above constitute unfair, unlawful
12 and fraudulent business practices and constitute violations of California Business
13 and Professions Code §17200.
14

15
16 47. Defendants’ conduct, in violation of California Business and Professions
17 Code §§14245, 14247 and 17200, *et. seq.*, has caused, and is likely to cause, public
18 confusion, deception, mistake and infringes ZPI’s rights and dilutes the distinctive
19 quality of the “Zorro” character, including its trademarks and trade dress, and good
20 will associated with them.
21

22
23 48. Irreparable harm to ZPI is imminent as a result of defendants’ conduct,
24 and ZPI is without an adequate remedy at law. ZPI is entitled to an injunction
25 restraining defendants, their officers, directors, agents, employees, representatives
26 and all other persons acting in concert with them, from engaging in further such acts.
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WHEREFORE, Plaintiff prays for judgment against Defendants as set forth more fully below.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays for judgment against Defendants as follows:

1 1. That Defendants, their officers, agents, employees, representatives,
2 servants, successors, assigns and all persons, firms, corporations or entities either
3 acting directly or indirectly in concert with them or under their direction, control or
4 authority be permanently enjoined from infringing in any manner Plaintiff's
5 protected rights and property;
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7 2. That Defendants be required to deliver to the Court for impoundment and
8 destruction all materials that infringe Plaintiff's rights;
9

10 3. That Defendants be required to pay to Plaintiff the damages sustained in
11 consequence of Defendants' conduct in an amount according to proof, of at least
12 \$500,000;
13

14 4. That Defendants be required to account for all gains, profits and advantages
15 derived by Defendants as a result of their infringement of Plaintiff's rights and/or
16 Defendants' unlawful trade practices and/or unfair competition and to pay all profits
17 obtained by Defendants as a consequence of their conduct in an amount, according to
18 proof, of at least \$500,000;
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20 5. That Defendants pay to Plaintiff treble and/or punitive damages for their
21 intentional and willful infringements and violations of law;
22

23 6. That Plaintiff recover its costs and reasonable attorneys' fees;
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25 7. For pre-judgment and post-judgment interest;
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1 8. Any penalties provided for by statute not expressly enumerated above; and

2 9. That Plaintiff be granted such other and further relief as the Court deems

3
4 just and proper.

5 DATED: March 22, 2010

LAW OFFICES OF ROSS L. LIBENSON

6
7
8 By: 

9 ROSS L. LIBENSON

10 Attorneys for Plaintiff ZORRO PRODUCTIONS, INC.

11
12 **DEMAND FOR JURY TRIAL**

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14 Pursuant to Federal Rule of Civil Procedure 38(b) and Local Rule 3-6(a),

15 Plaintiff ZPI hereby demands a trial by jury.

16
17 DATED: March 22, 2010

LAW OFFICES OF ROSS L. LIBENSON

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19
20 By: 

21 ROSS L. LIBENSON

22 Attorneys for Plaintiff ZORRO PRODUCTIONS, INC.